REMARKS

Restriction Requirement Under 35 U.S.C. §121

In the July 15, 2003 Office Action, the Examiner to whom the subject application is assigned required restriction to one of the following alleged independent and distinct inventions under 35 U.S.C. §121:

I. Claims 147-148 and 151-153, drawn to a method of obtaining a composition which comprises determining whether a chemical compound binds to a human Y4 receptor expressed on the surface of a mammalian cell transfected with a vector adapted for expressing the receptor in the cell, classified in class 435, subclass 7.21.

II. Claims 149 and 151-153, drawn to a method of obtaining a composition which comprises determining whether a chemical compound binds to and activates a human Y4 receptor expressed on the surface of a mammalian cell transfected with a vector adapted for expressing the receptor in the cell, classified in class 435, subclass 7.21.

III. Claims 150 and 151-153, drawn to a method of obtaining a composition which comprises determining whether a chemical compound binds to and activates a human Y4 receptor expressed on the surface of a mammalian cell transfected

with a vector adapted for expressing the receptor in the cell, classified in class 435, subclass 7.21.

The Examiner alleged that the inventions of the Groups I-III are independent, using separate steps, and having different effects. The Examiner alleged that the groups have different classifications and require separate prior art searches.

In response to this restriction requirement, applicants hereby elect, with traverse, to prosecute the invention of Group I. Applicants note that 35 U.S.C. §121 states, in part, that "[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require that the application to be restricted to one of the inventions." [Emphasis added].

Applicants request that the restriction requirement separating Group I from Groups II and III be withdrawn in view of the fact that the claims of Groups II and III are not independent of Group I, and do not define patentably distinct inventions.

There are two criteria for a proper requirement for restriction, namely (1) the invention must be independent and distinct; AND (2) there must be a serious burden on the Examiner if restriction is not required.

Under M.P.E.P. §802.01 "independent" means "there is no disclosed relationship between the subjects disclosed, that is, they are unconnected in design, operation, or effect." The claims of Group I are related to the claims of Groups II and III in that they are drawn to methods of obtaining a composition which comprises determining whether a chemical compound binds to a human Y4 receptor, thus they are connected in design and effect.

Applicants therefore respectfully assert that two or more independent and distinct inventions have not been claimed in the subject application because the groups are not independent under M.P.E.P. §802.01. Therefore, restriction is improper under 35 U.S.C. §121 and reconsideration is requested.

Additionally, applicants point out that under M.P.E.P. §802.01, the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden. Applicants maintain that there would not be a serious burden on the Examiner if restriction were not required. A search of prior art with regard to Group I will reveal whether any prior art exists as to Group II and Group III. Since there is no burden on the Examiner to examine Groups I-III in the subject application, the Examiner should examine the entire application on the merits.